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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/346,794	07/02/1999	TERRY P. SNUTCH	NMEDP001-2	2888

25225 7590 12/31/2002

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EXAMINER

BASI, NIRMAL SINGH

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 12/31/2002

24

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/346,794

Applicant(s)

Snutch et al

Examiner

Nirmal S. Basi

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 8, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-31 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 25-31 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### DETAILED ACTION

1. Amendment filed 10/8/02 (paper number 23) has been entered.

2. The Amendment filed 10/8/02 introduced three species to each of claims 25, 28 and 30.

Upon consideration of Applicants Amendment and the three new species added to the claims, in  
5 elected Group XVI, it is found that this application requires further restriction. The new Restriction  
with respect to Group XVI is:

#### *Election/Restriction*

3. This application contains claims directed to the following patentably distinct species of the  
claimed invention:

10 Species I corresponds to a nucleic acid comprising SEQ ID NO:23, Species II corresponds  
to a nucleic acid comprising SEQ ID NO:25, Species III corresponds to a nucleic acid comprising  
SEQ ID NO:27.

The claims of elected Group XVI are drawn to a method to identify a compound which  
behaves as an agonist for a T-type calcium channel by contacting the  $\alpha_1$  subunit of a heterologous  
15 T-type calcium channel with a compound, wherein said  $\alpha_1$  subunit is encoded by a nucleotide  
sequence which hybridizes to under conditions of stringency to a nucleic acid comprising SEQ ID  
NO:23, 25 or 27. The claims apply to numerous T-type calcium channel  $\alpha_1$  subunits. The nucleic  
acid comprising SEQ ID NO:23, 25 or 27 are three distinct classes of calcium channel subunits and  
constitutes recitation of an implied, mis-joined Markush group that contains multiple, independent  
20 and distinct inventions. Each of the different nucleic acids encode a distinct polypeptides with

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distinct structural or functional properties and therefore the methods of their use are independent and distinct. The nucleic acid comprising SEQ ID NO:23, 25 and 27 were grouped into distinct Groups III, IV and V respectively, in paper number 8 (10/4/000). Therefore, the use of each individual nucleic acid comprising SEQ ID NO:23, 25 or 27 is also considered distinct. The nucleic acid of  
5 Groups III-V are distinct for reasons of record, see paper number 8. Accordingly, these claims are subject to restriction under U.S.C. § 121. This requirement is not to be constructed as a requirement for election of species, since each of the compounds recited in alternative form is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution  
10 on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are no generic claims.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims  
15 are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

4. The response to Applicants Amendment filed in paper number 23 (10/8/02) is held in abeyance. Applicants arguments will be fully addressed upon election of one of the patentably distinct species of the claimed invention, disclosed above.

#### **Advisory Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi whose telephone number is (703) 308-9435. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 308-0294.


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Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

5 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Nirmal S. Basi  
Art Unit 1646  
December 24, 2002

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YVONNE EYLER, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600